

APPLICANT(S): GILREATH, Mark G.
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FILED: April 18, 2005
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REMARKS

The present response is intended to be fully responsive to all points of objection and/or rejection raised by the Examiner and is believed to place the application in condition for allowance. Applicants assert that the present invention is new, non-obvious and useful. Prompt consideration and allowance of the claims is respectfully requested.

Status of Claims

Claims 1-20 are pending in this application and have been rejected.

CLAIM REJECTIONS

35 U.S.C. § 102 Rejections

In the Office Action, the Examiner rejected claims 1-20 under 35 U.S.C. § 102(e), as being anticipated by Mazzei et al. (U.S. Patent No. 6,840,903). Applicants respectfully traverse this rejection in view of the remarks that follow.

Applicants note that Mazzei et al. was first published under U.S. Patent Appl. Publication No. 2003/0181789 on September 25, 2003, which is after the earliest claimed priority date of Applicants' application, October 21, 2002, the filing date of U.S. Provisional Application No. 60/419,558. Mazzei et al. is available as a reference against this application under 35 U.S.C. § 102(e) because Mazzei et al. was filed in the USPTO on March 21, 2002, which is prior to October 21, 2002. However, in accordance with 37 C.F.R. § 1.131 and Manual of Patent Examining Procedure § 715, Applicants may submit a declaration to antedate a reference that qualifies as prior art under 35 U.S.C. 102(e), where the reference has a prior art date prior to Applicants' effective filing date and shows but does not claim the same patentable invention.

Applicants herewith submit a Declaration of Rachel Bentov Under 37 C.F.R. § 1.132, wherein Ms. Bentov refers to a draft of U.S. Provisional Application No. 60/419,558 attached as Exhibit B thereto that was prepared in February 2002 (prior to March 21, 2002) with her direct participation when she was an outside contractor and served as outside counsel to the assignee Given Imaging through a law firm that is the predecessor to the law firm of the undersigned attorney for Applicants.

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Applicants herewith also submit a Declaration of Mark Gilreath Under 37 C.F.R. § 1.131 to show that the subject matter of pending claims 1-20 was conceived of by him, as the sole inventor of this application, prior to March 21, 2002. Mr. Gilreath refers to the copy of the draft provisional application that was prepared in February 2002 and attached as Exhibit B to the Declaration of Rachel Bentov, and refers to his recollection with respect to subject matter of the pending claims that is reflected in that draft provisional application. In his declaration, Mr. Gilreath asserts that the subject matter of pending independent claims 1, 11 and 17 was conceived by him as the inventor of this application prior to March 21, 2002. Accordingly, Applicants assert that the subject matter claimed in the pending claims 1-20 was conceived of by the inventor hereof prior to March 21, 2002.

Applicants also contend that that the inventors, the owner of this application and their attorneys were duly diligent from prior to March 21, 2002 to October 21, 2002, the filing date of U.S. Provisional Application No. 60/419,558, which is the constructive reduction to practice of this invention. Applicants refer to Exhibit A attached to the Declaration of Rachel Bentov Under 37 C.F.R. § 1.132, which shows a copy of a snapshot of the directory from Rachel Bentov's "old documents" directory at Given Imaging. That snapshot shows that there were at least five (5) further revised versions of a draft provisional application relating to the subject matter of this patent application within April and May, 2002. This directory does not reflect any later versions of the draft provisional application that were reviewed and revised subsequent to the time that Ms. Bentov joined the law firm that is the predecessor to the law firm of the undersigned attorney for Applicants as outside counsel to Given Imaging.

Applicants note that the relevant time period within 2002 was an extremely busy one for the assignee Given Imaging (which was at the time a young company) and its handful of attorneys. Within 2002, Given Imaging filed 41 new applications, of which 30 were based upon new patent application disclosures, and, in 2003, Given Imaging filed 71 new applications, of which 24 were based upon new patent application disclosures. Accordingly, the attorneys for Applicants, in addition to their normal workload from other clients, had a backlog of unrelated applications on which they worked diligently and expeditiously. Thus, any delay between the completion of the provisional application and its filing on October 21, 2002 was due to the attorneys' work backlog and does not detract from Applicants diligence in constructively reducing this application to practice.

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Thus, in view of the proofs provided in the attached Declaration of Mark Gilreath Under 37 C.F.R. § 1.131 and the attached Declaration of Rachel Bentov Under 37 C.F.R. § 1.132, Applicants argue that Mazzei et al. is no longer available as a reference against the subject patent application under 35 U.S.C. 102(e), and Applicants respectfully request that this rejections be withdrawn.

Accordingly, Applicants respectfully assert that claims 1-20 are allowable. Accordingly, Applicants respectfully request that the Examiner withdraw the rejections to pending claims 1-20.

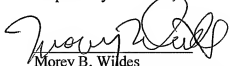
Conclusion

In view of the foregoing amendments and remarks, Applicants assert that the pending claims are allowable. Their favorable reconsideration and allowance is respectfully requested.

Should the Examiner have any question or comment as to the form, content or entry of this Amendment, the Examiner is requested to contact the undersigned at the telephone number below. Similarly, if there are any further issues yet to be resolved to advance the prosecution of this application to issue, the Examiner is requested to telephone the undersigned counsel.

Please charge any fees associated with this paper to deposit account No. 50-3355.

Respectfully submitted,


Morey B. Wildes
Attorney/Agent for Applicant(s)
Registration No. 36,968

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Pearl Cohen Zedek Latzer, LLP
1500 Broadway, 12th Floor
New York, New York, 10036
Tel: (646) 878-0800
Fax: (646) 878-0801